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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,693	09/29/2000	Mark A. Alcazar	MS1-657US	1489

7590

09/20/2005

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EXAMINER

SHAH, SANJIV

ART UNIT	PAPER NUMBER
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-2625

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/675,693	Applicant(s) ALCAZAR ET AL.	
	Examiner Sanjiv D. Shah	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/26/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 23-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Analysis: The claimed invention is not a computer program per se. It is a series of steps performed on a computer. Evaluating the process there is no pre-computer or post computer activity. The invention merely manipulates abstract idea or solves a purely mathematical problem without any limitation to a practical application. Consistent with definitions in the specification, the features of the claimed invention are not necessarily implemented in hardware. The claims are at best directed to an arrangement of software, per se and therefore is not tangible. This rejection can be overcome by incorporating language such as "implemented on a computer" in a preamble.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 23-29, 31-34, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's own admitted prior art in the background of invention in view of Remington et al. (Patent # 5,771,384).

Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37, applicant's own admitted prior art teaches a extensible document editor with event handler, wherein the extension is coupled to editor and the extension is configured to process editing events as described in the instant specification page 1, lines 7-page 2, line17.

Applicant's own admitted prior art although suggest providing editing events to the extension prior to default editor as described on page 2, lines 15-17, it fails to specifically teach extensibility mechanism providing the editing events to the extension prior to the default event handler processing the editing events. Remington et al do. Specifically, Remington et al. teaches the extension functionality as described in col. 4, lines 30-32. Event handlers are described in col. 4, lines 66-col. 5, lines 2. Providing the

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events to extension through pre-event and post-event processing prior to default processing is described in col. 9, lines 10-15. Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to implement event handling technique of Remington et al in the editor of applicant's own admitted prior art because it provides added flexibility for document editing over default processing.

Regarding claim 26, 27, 28, 31, Remington teaches a communication between event handler and default processing to continue processing or editing as described in col. 15, lines 25-36. Pre-event processing and post-event processing is described in col. 9, lines 10-15. Since the editor executes various commands, it is obvious that the command is translated for it to be processed. It would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate communication between event handlers and default processors because it aids in processing user desirable actions when requested.

Regarding claims 32 and 36, Remington teaches the claimed invention of event ID, i.e. event address as described in col. 14, lines 55-60.

Response to Arguments

5. Applicant's arguments filed 6/03/2005 have been fully considered but they are not persuasive.

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Applicant argues that 101 rejection is improper. Examiner disagrees. Specifically applicant argues that either "editor" or designer" on their face recite machine. Examiner disagrees. Editor or designer as described in specification are processing events that can enable macros to perform advanced tasks on the content of a document. Clearly they are programming steps. Even if considered as machine, they are not necessarily implemented on hardware and therefore are not tangible. Applicant further argues "The specification describes examples of subject matter recited in the claims that are not solely or necessarily a "process" or a series of steps performed on a computer".

Applicant's statement asserts that it could be a hardware implementation. Applicant further sites various figures as blocks indicating hardware. Also applicant sites that in the specification the document is stored in memory, cites routing controller etc to show a tangible implementation of the invention.

However, claimed invention is not limited by hardware and therefore is not tangible. The limitations from specification are not read into claims. Examiner suggests use of language such as "editor implemented on a computer" to overcome 101 rejection.

Applicant further argues that 103 rejection is improper. Specifically applicant argues that event handler is not disclosed in applicant's cited prior art. Examiner disagrees.

Specifically applicant's own admitted prior art does teach editor that acts on an event.

The broadest reasonable interpretation of event handler is any step or device or process that handles event. Editor does handle events as admitted by applicant's own cited prior art. Therefore applicant's argument is not persuasive.

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Applicant further argues "Remington has not been shown by office to teach extension functionality relating to "designer extensibility mechanism". Examiner disagrees.

Broadest reasonable interpretation of designer extensibility mechanism without defining designer is any extensibility mechanism and therefore applicant's arguments are not persuasive. Also applicant's own admitted prior art teaches one or more extensible editors coupled to (default) editor as described on page 2, lines 3-4. Remington is cited only for portion "editing events to the extension **prior** to the default event handler". Even to that extent applicant's own admitted prior art suggest inputting editing events prior to default editor as described on page 2, lines 16-17. Therefore applicant's arguments are not persuasive.

Applicant further argues that office action fails to suggest motivation and fails to show motivation in a reference. Examiner disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for combining is the knowledge generally available to one of ordinary skill in the art.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2625

S. Shah
September 15, 2005